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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,861	10/22/2001	Keiji Yurugi	Q66372	7705

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

PUTTLITZ, KARL J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 08/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,861

Applicant(s)

YURUGI ET AL.

Examiner

Karl J. Puttlitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Form 1449, or substitute thereof, for the IDS filed April 12, 2002 is missing. If Applicant submits this form in its next communication, the examiner will supply the required acknowledgments of consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See M.P.E.P. § 2173.02.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-14 and 16 recite that the radical R2 is an organic residue. The examiner appreciates that breadth is equated with indefiniteness. See M.P.E.P. § 2173.04 (Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 USC 112 second paragraph.). In this case, the term organic residue embraces an inordinate number of radicals and it is therefore unclear what applicants intend as the invention. The examiner notes that exemplary groups are listed on page 9 of the specification. Proper incorporation of the listed groups would overcome this portion of the rejection.

Claim 3, the term "coexist" is indefinite as it is used in the claim because the relationship between the recited radical polymerization inhibitor and basic compound is unclear, i.e., do the recited ingredients contact one another.

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Claims 4-7 recite "method of handling a vinyl ether group-containing (meth)acrylic ester which comprises handling in the condition such that . . .". It is unclear if handling refers to storing or transporting. The phrase "handling in the condition such that" is confusing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 2142

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,692,256 to Bauer et al. (Bauer).

The invention is drawn to, inter alia, a vinyl ether group-containing (meth)acrylic ester composition which comprises a radical polymerization inhibitor and a vinyl ether group-containing (meth)acrylic ester represented by the following general formula:



The invention also claims, for example, processes of handling a vinyl ether group-containing (meth)acrylic ester which comprises handling a vinyl ether group-containing (meth)acrylic ester in a lightproof structure while keeping a molecular oxygen concentration in the gaseous phase within said lightproof structure at 0.01 to 22% by volume and said vinyl ether group-containing (meth)acrylic ester being represented by the following general formula above.

The instant invention also claims A method of producing a vinyl ether group-containing (meth)acrylic ester represented by the following general formula (1): $\text{CH}_2=\text{CR}_1-\text{COO}-\text{R}_2-\text{O}-\text{CH}=\text{CH}-\text{R}_3$ (1) in the formula, R1 represents a hydrogen atom or a methyl group, R2 represents an organic residue and R3 represents a hydrogen atom or an organic residue, which comprises reacting a hydroxyl group-containing vinyl ether

Bauer teaches esters of unsaturated carboxylic acids and vinyloxy-containing alcohols prepared through alcoholysis of an ester of an unsaturated carboxylic acid and a lower monohydric saturated aliphatic alcohol by reaction with a vinyloxy-containing

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alcohol in the presence of an alkaline transesterification or alcoholysis catalyst. See column 1.

Catalysts for promoting alcoholysis are strongly basic compounds which are anhydrous, such as sodium alcoholates, potassium alcoholates, or other alkali metal alcoholates, examples of which are given in the paragraph bridging columns 1 and 2.

Bauer teaches that it is often very helpful to have present during the reaction a small amount of a polymerization inhibitor, such as p-naphthol. See column 5

As an exemplary process, Bauer teaches in example 1 that methyl methacrylate, 150 parts of vinyloxyethanol, sodium methylate are mixed in methanol, and small amounts of p-naphthol and copper powder as inhibitors. The mixture was heated in a jacketed reaction vessel and the binary mixture of methyl alcohol and methyl methacrylate was distilled from the mixture.

The difference between Bauer and the claimed inventions is that Bauer does not teach the invention with particularity so as to amount to anticipation (See M.P.E.P. § 2131: "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipse dixit* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).).

Even in the context of obviousness, although the claimed invention may be encompassed by Bauer, this by itself does not render the invention obvious. *In re Baird*, 29 USPQ 2d 1550, 1552 (Fed. Cir. 1994).

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However, based on the above, Bauer teaches the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill (the prior art reference teaches or suggests all the claim limitations with a reasonable expectation of success. See M.P.E.P. § 2143.

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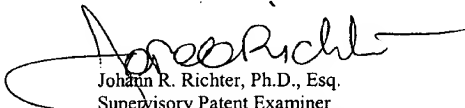
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (703) 306-5821. The examiner can normally be reached on Monday-Friday (alternate).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (703) 308-4532.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Karl J. Puttlitz
Assistant Examiner



Johann R. Richter, Ph.D., Esq.
Supervisory Patent Examiner
Biotechnology and Organic Chemistry
Art Unit 1621
703-308-4532

August 5, 2003